



10 JAN 2007

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In re Application of
MICHAEL J. HUDSON
Application No.: 10/562,593
PCT No.: PCT/AU04/00879
Int. Filing Date: 1 July 2004
Priority Date: 1 July 2003
Attorney's Docket No.: DUMME40.002APC
For: GRASS GROWING SUPERSTRATE AND
METHODS OF USE

DECISION ON
PETITION
UNDER 37 CFR 1.47(b)

This is a decision on petition under 37 CFR 1.47(a), which is being treated as a petition under 37 CFR 1.47 (b)¹, filed 03 November 2006 to permit petitioner (applicant) to file the above-captioned application on behalf of the non-signing inventor Michael J. Hudson. The five month extension of time fee has been paid.

BACKGROUND

On 1 July 2004, applicant filed international application No. PCT/AU04/00879 which claimed a priority date of 1 July 2003, and which designated the United States.

On 28 December 2005, within 30 months from the priority date, applicant filed a transmittal letter for entry into the national stage in the United States which was accompanied by, *inter alia*, basic national filing fee.

On 05 April 2006, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS indicating that the oath or declaration of the inventor, in compliance with 37 CFR 1.497(a) and (b) must be furnished within two months from the mail date of the notice or the application would be abandoned. Extensions of time were available.

On 03 November 2006, petitioner filed the instant petition requesting that the above-identified application be accepted under the provisions of 37 CFR 1.47(b). The petition was not accompanied by an executed declaration and a copy of an executed Assignment.

¹ 37 CFR 1.47(b) applies whenever all of the inventors refuse to execute the application or cannot be found or reached after diligent effort. Where a *sole* inventor refuses to sign or is unavailable to sign the application, a petition under 37 CFR 1.47(b) is required. A review of the published international application indicates that Michael J. Hudson is a sole inventor.

DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by (1) the requisite petition fee, (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage.

Petitioner has satisfied Item (1) with payment of the requisite petition fee and Item (3) with a statement of the last known address of the inventors.

With regard to Item (2), petitioner has submitted the declaration of Peter Chamberlayne Dummer. It is not clear from his declaration that Mr. Hudson received a complete copy of the application papers including specification, claims, drawings (if any) and declaration. Dummer states that on 29 May 2006, he sent Hudson correspondence "complete with US application attached"; however, by Dummer's admission, the "forms were sent to PO Box 4 instead of PO Box 46 so Mr. Hudson had not received them." (Dummer Dec., ¶3) On 20 June 2006, Hudson contacted one of Dummer's associates to confirm his postal address as he was expecting some documents but had not received them. Dummer called Hudson and Hudson indicated that he did not receive the documents and asked that they be sent again.

It is not clear that on 22 June 2006, the documents were sent again. The cover letter which accompanied the declaration does not indicate that a complete copy of the application accompanied the letter but just references "the outstanding forms" and "executed Declaration form". Furthermore, there is no evidence that the application was presented or delivered to Hudson. Dummer did not followup via telephone or email to Hudson to confirm receipt of the application. In addition, by Dummer's own recollection, Hudson indicated that he would be seeking legal advice on signing the documents. This is not an indication of refusal to sign.

Petitioner has not provided sufficient evidence that the inventor refuses to sign the application. See MPEP, 409.03(d), which states in pertinent part, "a refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers." Here, there is no evidence that the inventors were presented with a copy of the application papers and thus, there is insufficient evidence to conclude that the inventor refuses to sign the application. The statement of someone having first hand knowledge of the facts is required. Item (2) is not satisfied.

As for Item (4), petitioner has not provided a declaration executed on behalf of the inventor by the 37 CFR 1.47(b) petitioner. The declaration must be provided which fulfills the requirements of 37 CFR 1.497(a) and (b). Item (4) is not satisfied.

Regarding Item (5), Section 409.03(f) of the MPEP, Proof of Proprietary Interest, states, in part:

When an application is deposited pursuant to 37 CFR 1.47(b), the 37 CFR 1.47(b) applicant must prove that

- (A) the invention has been assigned to the applicant, or
- (B) the inventor has agreed in writing to assign the invention to the applicant, or
- (C) the applicant otherwise has sufficient proprietary interest in the subject matter to

justify the filing of the application.

If the application has been assigned, a copy of the assignment (in the English Language) must be submitted. The assignment must clearly indicate that the invention described in the 37 CFR 1.47(b) application was assigned to the 37 CFR 1.47(b) applicant. A statement under 37 CFR 3.73(b) by the assignee must also be submitted (see MPEP § 324)....

When an inventor has agreed in writing to assign an invention described in an application deposited pursuant to 37 CFR 1.47(b), a copy of that agreement should be submitted. If an agreement to assign is dependent on certain specified conditions being met, it must be established by a statement of facts by someone with first hand knowledge of the circumstances in which those conditions have been met. A typical agreement to assign is an employment agreement where an employee (nonsigning inventor) agrees to assign to his or her employer (37 CFR 1.47(b) applicant) all inventions made during employment. When such an agreement is relied on, it must be established by the affidavit or declaration of a person having firsthand knowledge of the facts that the invention was made by the employee while employed by the 37 CFR 1.47(b) applicant.

If the invention has not been assigned, or if there is no written agreement to assign, the 37 CFR 1.47(b) applicant must demonstrate that he or she otherwise has a sufficient proprietary interest in the matter.

A proprietary interest obtained other than by assignment or agreement to assign may be demonstrated by an appropriate legal memorandum to the effect that a court of competent jurisdiction (federal, state, or foreign) would by the weight of authority in that jurisdiction award title of the invention to the 37 CFR 1.47(b) applicant. The facts in support of any conclusion that a court would award title to the 37 CFR 1.47(b) applicant should be made of record by way of an affidavit or declaration of the person having firsthand knowledge of same. The legal memorandum should be prepared and signed by an attorney at law familiar with the law of the jurisdiction involved. A copy (in the English language) of a statute (if other than the United States statute) or a court decision (if other than a reported decision of a federal court or a decision reported in the United States Patents Quarterly) relied on to demonstrate a proprietary interest should be made of record.

Here, petitioner is attempting to prove that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the subject matter to justify filing the application. No assignment was attached to the petition to prove this interest. Nor has Petitioner provided an employment agreement where an employee (nonsigning inventor) agrees to assign to his or her employer (37 CFR 1.47(b) applicant) all inventions made during employment and a firsthand knowledge statement that the invention was made by the employee while employed by the 37 CFR 1.47(b) applicant.

Where there is no written agreement to assign or the invention has not been assigned, petitioner must demonstrate a proprietary interest by an appropriate legal memorandum. No such memorandum accompanied the petition. As stated above and reiterated here, an appropriate legal memorandum to the effect that a court of competent jurisdiction (federal, state, or foreign) would by the weight of authority in that jurisdiction award title of the invention to the 37 CFR 1.47(b) applicant is required. The facts in support of any conclusion that a court would award title to the 37 CFR 1.47(b) applicant should be made of record by way of an affidavit or declaration of the person having firsthand knowledge of the same. The legal memorandum should be prepared and signed by an attorney at law familiar with the law of the jurisdiction involved. A

copy (in the English language) of a statute (if other than the United States statute) or a court decision (if other than a reported decision of a federal court or a decision reported in the United States Patents Quarterly) relied on to demonstrate a proprietary interest should be made of record. A statement under 37 CFR 3.73(b) by the assignee must also be submitted. Item (5) is not satisfied.

As for Item (6), irreparable damage may be established by a showing (a statement) that a filing date is necessary to preserve the rights of the party and to prevent irreparable damage." No such statement has been presented. Thus, item (6) is not yet satisfied.


Accordingly, items (2), (4), (5) and (6) above have not been satisfied and the petition under 37 CFR 1.47(b) must be dismissed.

CONCLUSION

The petition under 37 CFR 1.47(b) is **DISMISSED WITHOUT PREJUDICE**.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.


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